

REMARKS

Claims 1-17 and 19-21 are pending in this application. By this Amendment, claims 20 and 21 are added to recite additional features disclosed in the specification at, for example, page 9, line 19-page 10, line 7.

Reconsideration of the application is respectfully requested.

The Examiner is respectfully requested to acknowledge consideration of the references listed on, and to return initialed copy of, the Form PTO-1449 filed with the September 13, 2005 Information Disclosure Statement.

Applicants thank Examiner Ackun for the courtesy extended to Applicants' representative, Mr. Luo, during the January 5, 2007 telephone interview. The substance of the telephone interview is incorporated in the following remarks.

The Office Action rejects claims 1-17 and 19 under 35 U.S.C. §102(b) or, in the alternative, §103(a) over U.S. Patent No. 5,487,694 to Deming et al. ("Deming"). This rejection is respectfully traversed.

Deming discloses using a band saw. See col. 1, lines 42-54. The Office Action asserts that Deming's band saw is the same as the bead saw recited in the claims. This assertion is inaccurate.

A band saw is a power saw for woodworking, consisting of a toothed metal band coupled to and driven around two wheels. See The American Heritage College Dictionary (3rd. Ed.). Thus, a band saw is characterized by a metal band with teeth.

On the other hand, a bead saw includes a wire and a plurality of bead-shaped members fixed on the wire at a certain pitch. See the specification at, for example, Fig. 1A and page 9, line 19-page 10, line 7. Thus, a bead saw is characterized by bead members fixed on a wire at a certain pitch.

In view of the above, a bead saw and a band saw are different devices having different features. Thus, Deming's band saw does not disclose or suggest a bead saw, as recited in the claims.

The Office Action further asserts that Deming's band saw renders obvious the bead saw recited in the claims. To support this assertion, the Office Action alleges that it would have been obvious in view of Deming to employ a bead saw in order to provide the known advantages of the band saw. However, the Office Action produces no evidence regarding what "known advantages" of the band saw may be provided in the context of the subject matter recited in the claims. For example, the Office Action fails to refer to a reference, or a portion of Deming that provides the "known advantages" of using a band saw in connection with the subject matter recited in the claims. The Examiner is required to identify specifically where teaching is found to establish *prima facie* case of anticipation, so that Applicants can recognize and seek to counter the grounds for rejection. See Chester v. Miller, 15 USPQ2d 1333, 1337 (Fed. Cir. 1990). The Office Action fails to provide a motivation to use a bead saw in place of a band saw in Deming's disclosure. Thus, the Office Action fails to establish a *prima facie* case of obviousness.

In particular, Deming does not recognize the advantages of using a bead saw. On the other hand, the present application discloses the use of a bead saw such that an excessive force is unlikely to be applied to the honeycomb structure to be processed, because a bead saw appropriately sags due to its linear shape. See the specification at, for example, page 13, lines 3-5. Deming does not disclose or suggest such an advantage of using a bead saw. Therefore, Deming does not disclose or suggest using a bead saw in place a band saw.

In fact, Deming points out disadvantages of using a band saw and even "sawing" all together. See col. 1, lines 46-49. Thus, Deming teaches away from sawing, regardless whether using a band saw.

For at least the above reasons, Deming does not disclose or suggest a bead saw. Therefore, Deming does not disclose or suggest the subject matter recited in claim 1, and claims 2-17 and 19 depending therefrom. Accordingly, withdrawal of the rejection of claims 1-17 and 19 under 35 U.S.C. §102(b) and §103(a) is respectfully requested.

The Office Action rejects claims 1-17 and 19 under 35 U.S.C. §102(b)/(e) or, in the alternative, §103(a) over U.S. Patent Publication No. 2003/0121596 to Greven, U.S. Patent No. 5,837,084 to Barss, U.S. Patent No. 3,739,679 to Schwend, and U.S. Patent No. 4,111,085 to Johnson. These rejections are respectfully traversed.

The Office Action merely asserts that Greven, Barss, Schwend and Johnson are similar to Deming, therefore disclose or suggest the subject matter recited in the claims, as Deming does. The Office Action fails to identify relevant portions of these references where each of the claimed elements is believed to be disclosed, or where motivation is believed to be suggested to use a bead saw in place of a band saw. Thus, the Office Action fails to establish a *prima facie* case of rejection. Again, the Examiner is required to identify specifically where teaching is found to establish *prima facie* case of anticipation, so that Applicants can recognize and seek to counter the grounds for rejection. See Chester v. Miller, 15 USPQ2d 1333, 1337 (Fed. Cir. 1990).

In any event, Greven, Barss, Schwend and Johnson do not disclose or suggest a bead saw, as recited in the claims. Thus, they do not disclose each and every element recited in the claims.

Furthermore, Greven, Barss, Schwend and Johnson do not suggest the use of a bead saw in place of other devices, such as a band saw. Therefore, they do not render the subject matter recited in the claims.

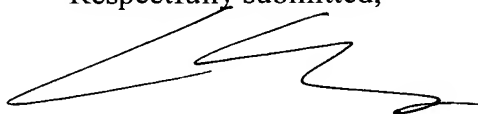
For at least the above reasons, withdrawal of the rejection of claims 1-17 and 19 under 35 U.S.C. §102(b), §102(e), or §103(a) is respectfully requested.

Claims 20 and 21 are believed to be patentable at least in view of the patentability of claim 1, from which they depend, as well as for additional features they recite.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-17 and 19-21 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Gang Luo
Registration No. 50,559

JAO:GXL/rle

Date: January 9, 2007

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
--